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09/237,827	01/27/1999	JOHN S. HENDRICKS	033033.00013	7009
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ARENT FOX LLP			SALCE, JASON P	
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WASHINGTON, DC 20036			PAPER NUMBER	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Office Action Summary	Application No. 09/237,827	Applicant(s) HENDRICKS ET AL.	
	Examiner JASON SALCE	Art Unit 2421	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2012.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 5) ☒ Claim(s) 1-31,63 and 107-109 is/are pending in the application.
- 5a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 6) ☐ Claim(s) ____ is/are allowed.
- 7) ☒ Claim(s) 1-31,63 and 107-109 is/are rejected.
- 8) ☐ Claim(s) ____ is/are objected to.
- 9) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

* If any claims have been determined allowable, you may be eligible to benefit from the **Patent Prosecution Highway** program at a participating intellectual property office for the corresponding application. For more information, please see http://www.uspto.gov/patents/init_events/pph/index.jsp or send an inquiry to PPHfeedback@uspto.gov.

Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 3) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____. | 4) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114 was filed in this application after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 9/24/2012 has been entered.

Response to Arguments

Applicant's arguments filed 9/24/2012 have been fully considered but they are not persuasive.

The Examiner notes that amendment applied to the independent claims do not overcome the prior art previously used to reject the claims. Applicant has amended the claims to state "***means for storing the subscriber-created data associated with individual electronic books located in the collection of electronic books directly in at least one field in a header file for each of the individual electronic books***".

The Examiner notes that Cassorla teaches that the annotations are stored directly in at least one field in a header file in Figure 6 and Column 10, Lines 20-22 for teaching a

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header file with three fields: a "Bookmark" field and two "Note" fields. Therefore, Cassorla teaches the newly added independent claim limitations (**see updated rejection below**).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-13, 18-29, 63 and 107-109 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshimune et al. (U.S. Patent No. 6,438,233) in view of Cassorla et al. (U.S. Patent No. 5,146,552).

Referring to claim 1, Yoshimune discloses a system for transmitting and receiving text (**see Figure 49 for an electronic book system that transmits and receives electronic book text**), and displaying an indication of the text (**see display unit 66 in Figure 50**), wherein the text is transmitted in an electronic signal (**see Figure 49 for the electronic book being transmitted to terminal 55D through an electronic signal and Figure 50 for the electronic book being transmitted from book display unit 63D to display unit 66 through an electronic signal**).

Yoshimune also discloses a processor that produces an electronic signal containing a representation of textual data corresponding to one or more electronic

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books (see **Figure 8 for the computer 56 having a processor 81 that controls the elements of computer 56, such as the display controller 85, which generates the electronic book displayed on display unit 66 (see Column 14, Lines 54-64).**

Yoshimune also discloses a transmitter, connected to the processor that transmits the electronic signal (see **Figure 8 and Column 14, Lines 54-64 for the display controller 85 connected to processor 82, which transmits the electronic book/signal to the display unit 66).**

Yoshimune also discloses a home subsystem (see **terminal 55D in Figure 49**), wherein the home subsystem includes:

a connector that receives the electronic signal (see **the bus connecting the component in Figure 8 for receiving the electronic signal from the broadcast receiving interface 87)**

means, connected to the connector, for selecting a portion of the textual data (see **book data management unit 62 in Figure 50 and the keyboard interface 88 and mouse interface 89, which receives selections from operation input unit 65 (see Column 13, Lines 38-56), wherein the user selects a portion of textual data (see Figure 31 for a user selecting a portion “COMICSXX” from the “COMICS” textual data)**), comprising means for receiving a subscriber entry indicating a title of an electronic book (see **again Figure 31 for selecting a title “COMICSXX”**), wherein the title correlates to a portion of the textual data (see **again Figure 31 for the title “COMICSXX” corresponding to a portion of the “COMICS” textual data).**

an electronic collection of electronic books (**see again book data management unit 62 and book data storage unit 61 attached to memory 64 in Figure 50**), ordered and transmitted electronically via the transmitter (**see Column 13, Lines 38-56**), wherein in response to a transmitted order, the ordered electronic book is transmitted from a remote operations center to the home subsystem and stored in the library unit of the home subsystem until a selection is received to view the electronic book (**see Column 11-18 for a transmitted order being made from a book data broadcast management unit 53 according to registered broadcast schedule and Column 13, Lines 24-37 for receiving the ordered electronic books**).

means for associating subscriber-created data with individual electronic books located in the collection of electronic books (**see Figure 53 for allowing a user to enter subscriber-created data associated with the electronic books viewed by a user on a display unit, wherein the displayed book is an electronic book selected by the user from the collection of electronic books**).

means for storing the subscriber-created data with individual electronic books (**see Figures 51-53 for entering subscriber-created data with an individual electronic book (the Examiner notes that by entering the data on the display screen along with the displayed electronic book that both the displayed electronic book and subscriber-created data are both inherently stored in a display buffer/storage until the user accesses the transmission button to transmit the data back to the central facility/book server)**) located in the collection of

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electronic books (**see again book data storage unit 61 and memory 64 where the individual electronic book is located in the collection of electronic books**).

means for receiving a subscriber-entered selection (**see Column 13, Lines 38-56 for receiving a book selection**).

a menu generator that determines and generates a particular library of the books located in the collection based on a default menu and generates a searchable menu of the electronic books in the electronic book collection (**see Column 13, Lines 41-44 for generating a book menu that contains a searchable menu of electronic books from the electronic book collection stored in memory unit 64**).

means for selecting search criteria for the searchable menu based on the subscriber-entered selection (**see Column 13, Lines 44-47 for specifying search criteria such as author name**).

a display, connected to the connector (**see display unit 66 in Figures 8 and 50**), that displays the particular library menu of books relating to the determination of the menu generator (**see Column 13, Lines 41-44 for displaying the menu generated**), and displays the subscriber-created data associated with each of the books included in the particular library menu (**see Figure 53 and Column 41, Line 55 through Column 42, Line 57 for displaying the subscriber-created data on the display unit 66**).

Yoshimune fails to teach that the subscriber-created data is stored in a header file for each of the individual electronic books.

Cassorla also discloses a means for associating subscriber-created data with individual electronic books located in the collection of electronic books and means for storing the subscriber-created data associated with individual electronic books located in the collection of electronic books directly in at least one field in a header file for each of the individual electronic books (**see Column 5, Lines 31-50, Figure 6 and Column 10, Lines 20-22**).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the data entered in Figure 53, as taught by Yoshimune, using the subscriber-created data header file storage area, as taught by Cassorla, for the purpose of providing annotations which are related to a particular location in an electronic book (**see Column 2, Lines 8-10 of Cassorla**).

Referring to claim 2, Yoshimune also discloses that the processor produces the electronic signal as a video formatted composite signal (**see Figure 6 for the electronic book data transmitted over a video formatted composite signal which is separated by the data signal separation circuit 68 after demodulating the video formatted composite signal by the channel selection and demodulation circuit 57**).

Referring to claim 3, Yoshimune also discloses that the processor produces the electronic signal as a signal to be transmitted over a telephone system (**see Figure 3A and Column 5, Lines 24-36**).

Referring to claim 4, Yoshimune also discloses displaying an electronic representation of books on a book shelf, related to the textual data (**see Figure 31**).

The Examiner notes that the claim fails to state an actual graphical representation of a book on a shelf and that the claim limitation electronic representation is broad, wherein a list of books to choose from is an electronic representation of multiple books that can be selected from various locations a list/bookshelf.

Referring to claim 5, Yoshimune also discloses that the display formats the menu according to title (**see Figure 31 for displaying the books by title**).

Referring to claim 6, Yoshimune also discloses that the display comprises a microprocessor that receives an indication of a selected portion of the textual data identified by the menu, and wherein the display displays the selected portion of the textual data (**see Column 32, Line 60 through Column 33, Line 2 for selecting a comic book for display in Figure 31 and displaying the comic book in Figure 32**).

Referring to claim 7, Yoshimune also discloses that the display displays a default menu (**see Figure 31 for displaying a default category menu that allows a user to select a COMICS default category**).

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Referring to claim 8, Yoshimune also discloses that the connector comprises a set top terminal (**see broadcast receiver 57 in Figure 6**) with a memory for storage of the selected textual data (**see book data storage unit 61 in Figure 6**), and the display comprises a television (**see Column 44, Lines 25-39 for receiving books over a television broadcast and Figure 4A for displaying video text at a host terminal, therefore teaching a television display**).

Referring to claim 9, Yoshimune also discloses that the display comprises a portable, hand-held viewer (**see Column 16, Lines 15-22**).

Referring to claim 10, Yoshimune also discloses that the processor comprises an encoder (**see Figure 6 for a book data display unit 63, which formats/encodes the book data into a signal displayable by the display unit 66**).

Referring to claims 11-12, Yoshimune also discloses a broadcast television transmitter or a cable television transmitter (**see Column 44, Lines 25-39 for Yoshimune transmitting television broadcasts with incorporated book data and Column 40, Line 66 through Column 41, Line 2 for transmitting over cable or broadcast medium (UHF, VHF)**).

Referring to claim 13, Yoshimune also discloses that the connector further comprises a cable connector, that extracts textual data from a video formatted

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composite signal (**see broadcast receiver 57 in Figure 6 and Column 12, Lines 34-67**).

Referring to claims 18 and 107-108, see the rejection of claim 1.

Referring to claims 19-27 and 29, see the rejection of claims 2-17.

Referring to claim 28, Yoshimune discloses using a cable television transmitter to send the textual data (**see Column 40, Line 66 through Column 41, Line 2**), but fails to teach sending the textual data without any video or using the textual data to fill an entire channel of video.

The Examiner takes Official Notice to the fact that text data can be transmitted without any video and that the text data can fill an entire channel of video.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the transmission system, as taught by Yoshimune and Cassorla, using the dedicated text channel, as stated by the Examiner's Official Notice, for the purpose of a faster and more efficient transmission and receipt of textual data requested by a user.

Referring to claims 63 and 109, see the rejection of claim 1 and further note that Yoshimune teaches that the electronic purchase order is transmitted from the library unit to the remote operations center (**see Column 43, Line 60 through Column 44, Line 2**).

Claims 14-17 and 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshimune et al. (U.S. Patent No. 6,438,233) in view of Cassorla et al. (U.S. Patent No. 5,146,552) in further view of Kubota (U.S. Patent No. 5,506,902).

Referring to claim 14, Yoshimune and Cassorla discloses all of the limitations of claim 1, however Yoshimune fails to detail the components contained within display 66 in Figures 8 and 50, thereby failing to teach the limitations of claim 14.

Kubota discloses a display (**recorder 7, disc 8 and portable terminal 9 in Figure 1**) that comprises a library unit connected to the connector, for processing the textual data (**see recorder 7/disc8 in Figures 1 and 14**) comprising: digital logic for screening the textual data (**see recording medium driver 43 in Figure 14**) a first memory for storing the textual data (**see recording medium (HD) 42**) and a viewer, electronically communicating with the library unit, for displaying the textual data as text (**see viewer 9 in Figure 1 which electronically communicates by placing the disc 8 into viewer 9, wherein disc 8 loaded data from recorder 7**).

Referring to claim 15, Kubota also discloses that the disc 8 (**part of the library unit**) and the viewer 9 are within a common housing (**the viewer 9 with disc 8 loaded**).

Referring to claim 16, Kubota also discloses that the viewer discloses a second memory for storing textual data received from the library unit (**see disc 8 which is placed into the viewer 9 in Figures 1 and 14**), a microprocessor, connected to the

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second memory, for controlling the functions of the viewer (**see Column 9, Lines 24-26 for retrieving text data from the disc 8 loaded into viewer 9, which therefore teaches a microprocessor device, otherwise the viewer 9 could not load the text data from disc 8**) and a digital display circuit, connected to the microprocessor, for creating displays (**see Figures 12a-12b and Column 10, Lines 1-9 for displaying text on the viewer 9, therefore the viewer contains a digital display circuit, otherwise the text data could not be displayed**).

Kubota fails to teach an LCD, connected to the digital display circuitry, for displaying text.

The Examiner takes Official Notice to the fact that LCD displays were well known in the art at the time the instant invention was made.

Therefore, one of ordinary skill in the art would recognized modifying the viewer, as taught by Yoshimune, Cassorla and Kubota, using an LCD screen, as stated by the Examiner's Official Notice, for the purpose of providing a clear, easy to read display screen for reading text data.

Referring to claim 17, Kubota discloses that the second memory for storing textual data comprises a removable electronic card memory (**see Figures 1 and 14 for disc 8**).

Referring to claims 30-31, see the rejection of claims 14-17.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JASON SALCE whose telephone number is (571)272-7301. The examiner can normally be reached on M-F 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine L. Kincaid can be reached on (571) 272-4063. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jason Salce/
Primary Examiner, Art Unit 2421

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November 16, 2012